

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Scott Anthony Morgan et al.
Serial No.: 09/213,856
Confirmation No.: 6318
Filed: December 17, 1998
For: SPEECH COMMAND INPUT RECOGNITION SYSTEM FOR
INTERACTIVE COMPUTER DISPLAY WITH INTERPRETATION
OF ANCILLARY RELEVANT SPEECH QUERY TERMS INTO
COMMANDS
Examiner: A. A. Armstrong
Art Unit: 2626

Certificate of Electronic Filing Under 37 CFR 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: October 7, 2010

Signature: *Elisabeth Dunker* (Elisabeth Dunker)

REQUEST FOR RECONSIDERATION OF DECISION ON PETITION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

On August 11, 2010, the Office of Petitions mailed a Decision On Petition in response to the Petition To The Director Of the USPTO Under 37 C.F.R. §1.181 filed on July 16, 2006. The Decision On Petition indicated that the Petition Under 37 C.F.R. §1.181 is dismissed, but indicated that if proof that a terminal disclaimer was filed on October 6, 2004 were submitted, the Petition Under 37 C.F.R. §1.181 would be reconsidered. Proof of the filing of the terminal disclaimer is submitted herewith, and reconsideration of the petition is respectfully requested.

Specifically, a Notice of Abandonment was mailed March 22, 2005 which indicated that this application was abandoned as a result of Petitioner's failure to take appropriate action following the September 22, 2004 decision from the Board of Patent Appeals and Interferences (BPAI). In the

Petition Under 37 C.F.R. §1.181 filed on July 16, 2006, the Petitioner pointed out that, after the decision from the BPAI, a terminal disclaimer was filed on October 6, 2004, which put all of the claims of this application in condition for allowance. Petitioner argued that the Examiner should have taken action in this application once the terminal disclaimer was filed.

In the Decision on Petition, the Office of Petitions agrees that the Examiner should have taken up action after the filing of such a terminal disclaimer, but indicates that no terminal disclaimer is of record in the application. The Decision indicates that if proof of filing of the terminal disclaimer is submitted, the Petition Under 37 C.F.R. §1.181 will be reconsidered.

The current assignee of the present application, Nuance Communications, Inc., acquired this application from the previous assignee after the filing of the Petition Under 37 C.F.R. §1.181. However, based upon a review of the file, it appears that the previous assignee did file a terminal disclaimer on October 6, 2004. Specifically, the current assignee found a Response and a terminal disclaimer (with a signed Certificate of Facsimile Transmission) dated October 6, 2004 in the file, along with an Auto-Reply Facsimile Transmission from the USPTO that confirms receipt of these papers by the USPTO on October 6, 2004. Copies of the response and terminal disclaimer filed on October 6, 2004 along with the Auto-Reply Facsimile Transmission from the USPTO confirming receipt of these papers are attached hereto.

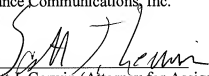
In view of the evidence of submission of a terminal disclaimer on October 6, 2004, reconsideration of the Petition Under 37 C.F.R. §1.181 is respectfully requested.

CONCLUSION

In view of the above, the assignee respectfully requests that Petition under 37 C.F.R. §1.181 be granted. The assignee believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 23/2825 under Docket No. N0484.70331US00 from which the undersigned is authorized to draw.

Dated: October 7, 2010

Respectfully submitted,
Nuance Communications, Inc.

By 
Scott J. Gerwin (Attorney for Assignee)
Registration No.: 57,866
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IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
11400 BURNET ROAD
AUSTIN, TEXAS 78758
FAX # 512

DATE: 10/6/04Number of Pages to Follow (including cover sheet) 6

SEND TO: United States Patent Office

Examiner: A. ArmstrongGroup Art Unit: 2654

Tel No:

703- 308-6258

Fax #:

703- 872-9306

FROM:

J. B. Kraft

Tel No:

512- 473-2203

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Docket No. A7980343 Serial No. 09/13, 856 Atty: J. B. KraftApplicant: S. A. Morgan et al☐ Transmittal Letter (2 copies)☐ Certificate of Facsimile☐ Preliminary Amendment☐ Notice of Appeal☒ Amendment AF☐ Appeal Brief (3 copies)☐ Ext. of Time☐ Reply Brief☐ IDS Statement☐ Change of Address☒ Other Terminal DisclaimerDeposit Acct. No. 09-0447Fees: Amendment ☐ Notice of Appeal ☐ Appeal Brief ☐ Other ☐

PATENT
09/213,856

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Before the Examiner:
Scott A. Morgan et al. : Angela Armstrong
Serial No.: 09/213,856 : Group Art Unit: 2654
Filed: December 17, 1998 : Intellectual Property
Title: SPEECH COMMAND INPUT : Law Department - 4054
RECOGNITION SYSTEM FOR : International Business
INTERACTIVE COMPUTER DISPLAY : Machines Corporation
WITH INTERPRETATION OF : 11400 Burnet Road
ANCILLARY RELEVANT SPEECH : Austin, Texas 78758
QUERY TERMS INTO COMMANDS : Date: 10/6/04 JPK

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including a Response and an accompanying Terminal Disclaimer is being transmitted via facsimile to USPTO, Group Art Unit 2654 at telephone number 703-872-9306, and to the attention of Examiner A. Armstrong on October 6, 2004.

J. B. KRAFT
JPK 10/6/04
Signature Date

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is response to the Decision on Appeal (No. 2004-0143) mailed September 22, 2004 reversing the rejection of claims 1-3, 5-8, 10-13, and 15 under 35 U.S.C. 103.

These claims remain provisionally rejected based upon obvious type double patenting over the combination copending Application SN. 09/213,858 in view of Morin et al.. The

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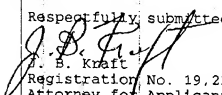
Examiner indicated that this rejection will be withheld until conflicting claims are found to be allowable.

Since, there is a common assignee of the cited application and the present application. Applicants indicated in their Brief on Appeal that assignee is prepared to submit an appropriate Terminal Disclaimer in the present Application.

During the pendency of the Appeal in the present Application, the claims of copending Application were found to be allowable. Accordingly, the accompanying Terminal Disclaimer is submitted disclaiming the terminal part of the statutory term of any patent granted on the present Application which would extend beyond the expiration date of the full statutory term of copending U. S. Patent Application, Serial No. 09/213,858 filed December 16, 1998.

Applicants respectfully request that the attached terminal disclaimer be entered, and claims 1-3, 5-8, 10-13, and 15 be allowed.

Respectfully submitted,



J. B. Kraft
Registration No. 19,226
Attorney for Applicants
(512) 473-2303

PLEASE MAIL ALL CORRESPONDENCE TO:

Mark S. Walker
IPLaw Dept. - IMAD 4054
IBM Corporation
11400 Burnet Road
Austin, Texas 78758

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09/213,856

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ANCILLARY RELEVANT SPEECH : Austin, Texas 78758
QUERY TERMS INTO COMMANDS : Date: 10/6/04

TERMINAL DISCLAIMER

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

The owner, International Business Machines Corporation, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of copending U. S. Patent Application, Serial No. 09/213,858 filed on December 16, 1998, S. A. Morgan et al., the term being defined in 35 U.S.C. Sections 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period it and U.S. Patent Application Serial No. 09/213,858 are commonly owned. This agreement runs with U.S. Patent Application Serial No. 09/213,858 and any patent granted on the instant application

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and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. Sections 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. Section 1.321, has all claims canceled by a reexamination certificate, is reissued or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

For submissions on behalf of an organization (e.g. corporation), the undersigned is empowered to act on behalf of the organization.

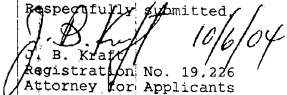
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,


J. B. Kraft
Registration No. 19,226
Attorney for Applicants
(512) 473-2303

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